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ATTORNEY DOCKET NO. 25006.0017U3
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
)	
Breaker <i>et al.</i>)	Art Unit: 1635
)	
Application No. 09/780,929)	Examiner: Schultz, James
)	
Filing Date: February 8, 2001)	Confirmation No. 6724
)	
For: NUCLEIC ACID CATALYSTS WITH)	
ENDONUCLEASE ACTIVITY)	

RESPONSE TO NOTICE OF DRAWING INCONSISTENCY WITH SPECIFICATION

Mail Stop: ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

NEEDLE & ROSENBERG, P.C.
Customer No. 23859

Sir:

This is responsive to the August 3, 2004 Notice of Drawing Inconsistency with Specification (Notice) mailed in the above-identified patent application. Submitted with this Response are a copy of Figure 8, a copy of the published application, and a copy of the stamped return postcard received from the Patent and Trademark Office indicating receipt of Figure 8 with the originally filed patent application.

REMARKS

The Notice refers to drawings filed on January 14, 2002. A review of PAIR indicates that the Notice is referring to the corrected drawings submitted in the Amendment filed November 7,

2001. The Notice states that an inconsistency exists between the drawings and the Brief Description of the Drawings in the Specification. Specifically, the Notice states that the Brief Description refers to Figure 8, but there was no Figure 8 contained in the drawings.

Applicants note that, contrary to assertions in the Notice, Figure 8 is contained in the drawings. Figure 8, a copy of which is submitted with this Response, was filed with the original application as indicated by the return postcard, a copy of which is submitted with this Response, indicating that 8 sheets of drawings were received by the Patent Office. As further proof, the As-Filed Image of the application figures in PAIR indicates that Figure 8 is present in the application (http://pair-direct.uspto.gov/final/images/pair_efw_image_loc_frames.html). Additionally, the present application has been published as Publication No. US2002/0151693, a copy of which is submitted with this Response. The published application contains 8 figures, including Figure 8, the allegedly missing figure.

Thus, Figure 8 was filed with the originally filed application, and a copy of Figure 8 is (or was) present in the file at the PTO. Notwithstanding this, a formal copy of Figure 8 is submitted with this Response. Based on the foregoing, Applicants assert that the inconsistency asserted in the Notice of Drawing Inconsistency With Specification does not exist, and respectfully request acknowledgement that Figure 8 was received by the Office with the originally filed application, and that United States Patent Application No. 09/780,929 will issue with Figure 8 as filed.

Applicants believe that the inconsistency alleged in the Notice originates in a misunderstanding of the corrected drawings submitted with Amendment filed on November 7, 2001. The drawings filed on November 7, 2001 were corrected to include annotations of nucleic

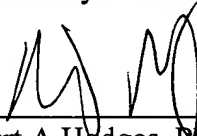
APPLICATION NO. 09/780,929

acid sequences required under 37 C.F.R. § 1.821-1.825. Because such sequences appear only in Figures 1-7, only these figures were corrected and submitted with the Amendment. Figure 8 was and remains a part of the application. It appears that the submission of corrected version of Figures 1-7 was misinterpreted as submission of a complete set of drawings in the application. As the evidence discussed above indicates, this is not the case.

It is believed that no new matter is added by this submission and that the above-noted inconsistency is now corrected.

No fee is believed due; however, the Commissioner is hereby authorized to charge any amount which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,



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CERTIFICATE OF EXPRESS MAILING UNDER 37 C.F.R. § 1.10

I hereby certify that this correspondence, including any items indicated as attached or included, is being deposited with the United States Postal Service as Express Mail Invoice No. EL 992019040US in an envelope addressed to: Commissioner for Patents, Mail Stop: Issue Fee, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.


Michael Laird

8/20/04
Date

Hon. Commissioner of S/N to be assigned
Patents and Trademarks
Re: Applicant - Breaker et al.


Atty: AJT/LJAD
Docket No.:
MBHB00.884-H (500.002)

NUCLEIC ACID CATALYSTS WITH ENDONUCLEASE ACTIVITY

Sir:

Please place the Patent Office receipt stamp hereon and mail to acknowledge receipt of:

- ☒ Transmittal Letter (in duplicate)
- ☒ Specification (62 sheets including claims)
- ☒ Drawings (8 sheets)
- ☒ Declaration and Power of Attorney (3 sheets - unexecuted)
- ☒ Filing Fee Check

JC972 U.S. PTO
09/780929

02/08/01

Date Mailed: February 8, 2001
Fee Enclosed: \$1,512.00

Respectfully,
McDonnell Boehnen Hulbert & Berghoff
Attorney for Applicant

EL625520175US



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